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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,229	05/25/2001	Donald R. Youell JR.	ACP 2-021	2603

7590

11/10/2005

Jerry K. Mueller, Jr.
Mueller and Smith, LPA
7700 Rivers Edge Drive
Columbus, OH 43235

EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,229

Applicant(s)

YOUELL ET AL.

Examiner

Paul Durand

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) 6-23 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 and 24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 1/29/2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/9/2005 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyer (US 3,784,004).

In regard to claim 1, Meyer discloses the invention as claimed including a paperboard 12, having a front and back, placing an automobile part 14, that is comprised of a structural part such as a bearing, on the front of the paperboard, leaving front areas exposed and shrink wrapping the part onto the paperboard with film 16 (see Figs. 1-3, C1,L12-20, C3,L49-61 and C5,30-52).

In regard to claims 1 and 24, Meyer inherently discloses the invention as claimed including protecting the contents not only from corrosion or the external atmosphere, but also from impact through the use of the base pad or substrate 12 and the film 16 itself. Additionally in claim 1, it is also an inherent property of a package to be shipped to an end user after it has been packaged.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Gillio-tos et al (US 4,611,456).

Meyer discloses the invention substantially as claimed including a paperboard back. What Meyer does not disclose is the backing being comprised of a laminate. However, Gillio-tos discloses that it is old and well known in the art to use a backing 1, that can be comprised of a laminate as a means of increasing product durability (see Figs. 8,9 and C3,L20-23). Therefore it would have been obvious to one having ordinary skill in the art to have provided the invention of Meyer with a laminate backing as taught by Gillio-tos for the purpose of increasing product durability.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Engles Jr. (US 3,154,898).

Meyer discloses the invention substantially as claimed except for specific mention of an automobile part being comprised of metal composite or glass. However, Engles teaches that it is old and well known in the art of skin packaging to provide a structural automobile part (i.e. a part having structure) 10, that is comprised of composite metal and porcelain, which is shrink wrapped to a backing 14, by film 16 for the purpose of protecting the product from damage during transport (see Figs. 1-3, C1, L15-18 and C2, L59-69). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of Meyer with the specific skin packaged structural part as taught by Engles for the purpose of protecting the product from damage during transport.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer and Engles Jr. as applied to claims 1 and 3 and in further view of Kean (US 3,618,755).

In regard to claim 4, the modified invention of Meyer discloses the invention substantially as claimed as applied to claims 1 and 3 above including a packaged article can be comprised of bearings, clutches or various automobile or mechanical parts, which in the broadest reasonable interpretation could include a so called "structural" part (see C5, L30-52). What the modified invention of Meyer does not explicitly disclose is an automobile part that is comprised of window glass, door panel, hood, fender or combinations thereof. However, Kean teaches that it is old and well known in the art of shrink packaging to package glass sheets 21, such as the type found in a window, which are packaged on a corrugated paperboard panel 22 and then shrink wrapped with envelope 35 for the purpose of protecting a product during shipping. Therefore, it would

have been obvious to one having ordinary skill in the art to have provided the modified invention of Meyer with a packaged part comprised of window glass for the purpose of protecting a product during shipping.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Wilkinson (US 6,010,003).

Meyer discloses the invention substantially as claimed except for the method of placing the shrink-wrapped packages in a box or container. However, Wilkinson teaches that it is old and well known in the art to place an object "O" that has been shrink wrapped to a backing with wrap 172, in a container "C" for the purposes of protecting the item during shipping (See Figs. 16 and 17). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of Meyer with a shipping container as taught by Wilkinson for the purpose of protecting the items during shipping.

Response to Amendment

9. The affidavit under 37 CFR 1.132 filed 7/13/2004 is insufficient to overcome the rejection of claims 2-4 based upon Gillio-tos as applied to claim 2, and Engles as applied to claim 3 as set forth in the last Office action because:

- a. In paragraph 10, the letter from Richard Tracy is unsigned.
- b. In paragraph 11, no factual evidence has been provided of the breakage rate for single pack applications prior to the use of applicant's invention.
- c. In paragraph 12, no factual evidence has been provided to show a considerable decrease in the breakage rate after the use of applicant's invention.

d. In paragraph 17, no factual evidence has been provided to show a reduced breakage rate of 90%.

e. In paragraph 18, no factual evidence has been provided to show that Mac-Pack sales have increased 300% due to applicant's invention.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Moreover, The affidavit under 37 CFR 1.132 filed 9/9/2005 is insufficient to overcome the rejection of claim 1 upon Meyer as set forth in the last Office action because: it is an inherent property of the invention of Meyer, as well with any packaged product to provide a degree of protection from tactile impact

Response to Arguments

10. Applicant's arguments filed 9/9/2005 have been fully considered but they are not persuasive.

Applicant first argues that the amended matter to claim 1 and step "c" of the claims distinguishes the claim over the reference of Meyer. The examiner does not agree. First, the recitation of "decreasing damage during shipment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural

limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Moreover, the examiner asserts that the amended matter of step "c" is still deemed to read on the reference of Meyer in that Meyer *inherently* performs the function of decreasing damage to the part during shipping through the use of the backing pad 121 and the film itself. From the MPEP § 2112, "Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not *explicitly* disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection." Furthermore, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to *reasonably* support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In this instance the examiner vigorously asserts that the whole basis of a package in general is to protect the contents from damage, whether by oxygen, or by tactile damage. Reference number 12 refers to a pad, which in and of itself suggests some sort of impact protection from outside elements, let alone the use of a film, which inherently protects an object from some level of abrading damage. Still furthermore, the examiner asserts that a reference need not explicitly include terms such as "damage, break or ship" if it is an inherent property of the reference. Additionally, the examiner

further asserts that in addition to common knowledge in the art, it is inherent to ship a package whether it is 5 feet to a closet, or 5000 miles to a store or a factory.

Applicant further asserts through affidavit and arguments that the prior art reference of Meyer does not disclose the use of a structural automotive part. The examiner does not agree. While Meyer does disclose the preferred embodiment of his invention focuses around food, Meyer also states on Column 5, Lines 39-41 that embodiments for his invention also encompass "bearings, clutches or *various automobile* or mechanical parts." If a bearing is taken alone, the examiner asserts that is indeed structural, as that is the intended purpose of a bearing (i.e. to structurally bear loads or forces). Furthermore, given the broadest reasonable interpretation of various automobile parts and not even factoring the teaching of Kean as supplied above, the examiner asserts that this can also encompass structural automotive parts such as windshields, hoods or fenders.

Applicant further argues that Meyer is non-analogous art. The examiner does not agree and asserts that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is argues that the Meyer is in the field of applicant's endeavor in that it not only encompasses packaging, but as stated above can encompass automotive parts.

Art Unit: 3721

Applicant further argues against the insufficiency of applicant's affidavits. This is not persuasive. From the MPEP § 716.01:

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("It is well settled that unexpected results must be established by factual evidence." "[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant's heat shrinkable articles with those of the closest prior art, we conclude that appellant's assertions of unexpected results constitute mere argument."). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991).

If applicant is asserting that there is commercial success or a reduction of damaged shipments, the examiner asserts that it must be supported with factual evidence.

Lastly, from the MPEP § 713.09, regarding interviews:

Normally, one interview after final rejection is permitted. However, prior to the interview, the intended purpose and content of the interview should be presented briefly, preferably in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. See MPEP § 714.13.

Interviews may be held after the expiration of the shortened statutory period and prior to the maximum permitted statutory period of 6 months without an extension of time. See MPEP § 706.07(f).

A second or further interview after a final rejection may be held if the examiner is convinced that it will expedite the issues for appeal or disposal of the application.

Art Unit: 3721

It is not the policy of the office to make an action non-final if an interview does not occur due to a failure to contact the applicant. Moreover a phone interview was conducted on this application on 10/28/2003.

This action is non-final.

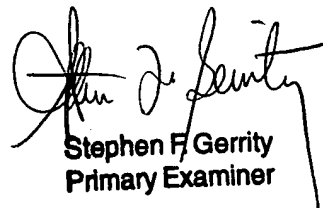
Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand
October 31, 2005


Stephen F. Gerrity
Primary Examiner